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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,368	01/28/2004	Shirleyanne E. Haye	86864JLT	4873

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EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,368

Applicant(s)

HAYE ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-14 and 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15 (broadest) and 1-12 with respect to the elected and applied species is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

This is in response to Paper filed on 28 March 2005.

I. Applicants elect the invention of Group I, claims 15(broadest) and 1-12 with traverse, being acknowledged. Since applicants could not be able to provide a reason for their traversal, it is properly treated as an election without traverse.

II. Applicants elect 2-aminoethanesulfonic (aminoethanesulfonic) acid species being acknowledged. The elected species has been considered and searched. The consideration and search are extent to the applied species. Others have not been considered, searched or examined until all of the elected and applied species are overcome.

III. Claims 15 (broadest), 1-3 and 5-12 are directed to the same invention as that of claims 1-10, 12, 15 in Patent No. 6,664,036 to Lowe et al of commonly assigned Eastman Kodak Company. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

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Failure to comply with this requirement will result in a holding of abandonment of this application.

IV. Claims 15(broadest), 1-3 and 5-12 are directed to an invention not patentably distinct from claims 1-10, 12 and 15 in Patent No. 6,664,036 to Lowe et al of commonly assigned Eastman Kodak Company.

Lowe et al claims encompass the limitations of the instant claims with respect to pH solution, amount of a color developing agent, amount of a hydroxylamine containing antioxidant (N,N-bis(ethylenesulfonato) hydroxylamine (on col.6:28-29), amount of an organic bonded direct to sulfo containing stabilizing (water-soluble organic co-solvent).

V. Claims 15 (broadest), 1-3 and 5-12 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-10, 12 and 15 of prior U.S. Patent No. 6,664,036 to Lowe et al. This is a double patenting rejection.

Lowe et al claims encompass the limitations of the instant claims with respect to pH solution, amount of a color developing agent, amount of a hydroxylamine containing antioxidant (N,N-bis(ethylenesulfonato) hydroxylamine (on col.6:28-29), amount of an organic bonded direct to sulfo containing stabilizing (water-soluble organic co-solvent).

VI. Claim 4 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-10, 12 and 15 of prior U.S. Patent No. 6,664,036 to Lowe et al considered in view of Seki (6,274,300). This is a double patenting rejection.

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Lowe et al claims encompass the limitations of the instant claims with respect to pH solution, amount of a color developing agent, amount of a hydroxylamine containing antioxidant (N,N-bis(ethylenesulfonato) hydroxylamine (on col.6:28-29), amount of an organic bonded direct to sulfonate containing stabilizing (water-soluble organic co-solvent).

Lowe et al claims do not specify a polycarboxylic acid as that in the instant claim 4. It is conventional and well known in the art to include a polycarboxylic acid as a calcium ion sequestering agent in a color photographic art. Evidence can be seen in at least Seki at col.17:31-54 and 29:46.

Since the above references are all related to aqueous silver halide color developing compositions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the known polycarboxylic acid from Seki in Lowe et al claims for a reasonable expectation of obtaining chelating actions against calcium ions in the aqueous compositions as disclosed, taught suggested and obtained in Seki.

VII. Claims 15 (broadest) and 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Lowe et al (6,664,036).

The applied reference has a common Eastman Kodak Company assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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Lowe et al disclose, teach, demonstrate and reduce to practice with the embodiments of the instant claims with respect to pH solution, amount of a color developing agent, amount of a hydroxylamine containing antioxidant (N,N-bis(ethylenesulfonato) hydroxylamine (on col.6:28-29), amount of an organic bonded direct to sulfo containing stabilizing (water-soluble organic co-solvent) and a chelating agent. Please see col.6:27-28 and Example 4 with respect to Tables IV and V.

Since Lowe et al disclose, teach, demonstrate and reduce to practice with the claimed embodiments, the above claims are found to be anticipated by Lowe et al.

VIII. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15 (broadest), 1-2 and 4-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Vincent et al (4,892,804).

Vincent et al disclose, teach, demonstrate and reduce to practice with the embodiments of the instant claims with respect to pH solution, amount of a color developing agent, amount of a hydroxylamine containing antioxidant, amount of an organic bonded direct to sulfo containing compound being read within the general formula I as claimed and a chelating agent. Please see Col.3:28-36, 4:27, 5:38-39, 49-60, 6:29-32 and 64-66, 7:1-4 and 14:9-22.

Since Vincent et al disclose, teach, demonstrate and reduce to practice with the claimed embodiments, the above claims are found to be anticipated by Vincent et al.

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IX. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent et al (4,892,804) considered in view of Haye et al (6,503,696).

Vincent et al do not specify a hydroxyl containing hydroxylamine organic antioxidant as that in the instant claim 3. Haye et al at col.5:31-36 is cited to show the known use of a hydroxyl containing hydroxylamine organic antioxidant in the art.

Vincent et al do not specify a color developing agent in its free base as that claim 11. Haye et al at col.3:13-14 and 4:23-24 are cited to show the known use of a color developing agent in its free base in the art.

Since the above references are all related to aqueous color developing composition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include or cited the use of a hydroxyl containing hydroxylamine organic antioxidant for a reasonable expectation of obtaining a stable composition as disclosed, taught and suggested in Haye et al and/or include or cite the use of a color developing agent in its free base for a reasonable expectation of sufficiently oxidize color forming couplers to produce a color image as disclosed, taught, suggested and obtained in Haye et al.

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X. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Komatsu et al (5,780,211).

Komatsu et al disclose, teach, demonstrate and reduce to practice with an aqueous color developing composition a sufficient amount of a color developing agent, a sufficient amount of an organic bonded direct to sulfo containing compound being read within the general formula I as claimed and a chelating agent. Please see col.41:25-59, 42:41 and 58-59, 43:23, 47:32-46, Table 5 “(1/2)”, “CD” with pH of “10.00” on cols. 49-50, 52:22-33 and Table 8 with (“Aminoethanesulfonic acid” being an adjacent homologue to the elected 2-aminoethanesulfonic acid) species) and “liquid”.

Since Komatsu et al disclose, teach, demonstrate and reduce to practice with the claimed embodiments, the above claim is found to be anticipated by Komatsu et al.

XI. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komatsu et al (5,780,211) considered in view of Haye et al (6,503,696).

Komatsu et al disclose, teach, demonstrate and reduce to practice with an aqueous color developing composition a sufficient amount of a color developing agent, a sufficient amount of an organic bonded direct to sulfo containing compound being read within the general formula I as claimed and a chelating agent. Please see col.41:25-59, 42:41 and 58-59, 43:23, 47:32-46, Table 5 “(1/2)”, “CD” with pH of “10.00” on cols. 49-50, 52:22-33 and Table 8 with (“Aminoethanesulfonic acid” being an adjacent homologue to the elected 2-aminoethanesulfonic acid) species) and “liquid”.

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Komatsu et al do not specify a hydroxyl containing hydroxylamine organic antioxidant as that in the instant claim 3. Haye et al at col.5:31-36 is cited to show the known use of a sufficient amount of a hydroxyl containing hydroxylamine organic antioxidant in the art.

Komatsu et al do not specify a color developing agent in its free base as that claim 11. Haye et al at col.3:13-14 and 4:23-24 are cited to show the known use of a color developing agent in its free base in the art.

Since the above references are all related to aqueous color developing composition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include or cited the use of a hydroxyl containing hydroxylamine organic antioxidant for a reasonable expectation of obtaining a stable composition as disclosed, taught and suggested in Haye et al and/or include or cite the use of a color developing agent in its free base for a reasonable expectation of sufficiently oxidize color forming couplers to produce a color image as disclosed, taught, suggested and obtained in Haye et al.

XII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent

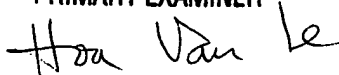
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Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
18 April 2005

HOA VAN LE
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive, flowing style with a horizontal line extending from the end of the name.